PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number
24207-10115

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Application Number	Filed
10/813,895	March 31, 2004

First Named Inventor	
David Benjamin Auerbach	
Art Unit	**Examiner**
2168	Greta Lee Robinson

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

☒ attorney or agent of record.
Registration number 39,713.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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June 20, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 of 1 forms is submitted.

ATTACHMENT TO THE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pre-appeal review is requested because the rejections of record are clearly improper and without any factual or legal basis. Applicants respectfully request that the Panel indicate claims 1-36 recite allowable subject matter.

I. Status of the Claims

Claims 1-36 are pending and stand finally rejected based on an Office Action mailed February 20, 2007. No claims have been amended since the last Office Action.

II. Rejection of Claims 35-36 under 35 USC § 102(b)

Claims 35-36 were rejected under 35 USC § 102(b) as allegedly being unpatentable over U.S. Patent No. 5,742,816 to Barr, et al. ("Barr"). With respect to claim 36, the claim recites, in part:

> "...capturing the at least one event upon the occurrence of the event..."
>
> and
>
> "...indexing and storing at least some of the event data and the media file associated with the event at a time after the occurrence of the event...
>
> ...wherein the time is based on performance data indicating a readiness to process the event and the position in the queue."

The rejection is improper because nowhere in the Office Action does the Examiner even address the limitation, "*wherein the time is based on performance data indicating a readiness to process the event and the position in the queue*". Thus, the Examiner clearly fails to establish that the reference teaches every element of the claim, as required by MPEP § 2131. Furthermore, a review of Barr reveals that the limitation is not disclosed or suggested anywhere in the reference. At best, Barr discloses schedulers 144 to "monitor and queue the searches

performed by search engines" (Barr, column 21, lines 19-21), but does not disclose queuing event data to be indexed and stored and does not disclose indexing and storing at a time based on performance data indicating a readiness to process the event.

The rejection is further improper because Barr does not disclose capturing one or more events and indexing and storing at least some of the event data and the media file associated with the event at a time after the occurrence of the event. Examples of events include playing an audio file, editing a video file, uploading an image file, sending or receiving an email message, etc. Additional examples are described in the specification at, for example, paragraph [0018].

In the Office Action, the Examiner incorrectly indicates that Barr's disclosure of receiving a search query is the same as capturing an event. However, the claim language clearly recites "capturing an event" as a distinct step from "receiving a search query," and specifically requires that indexing and storing the event data from the event occurs at a time after the occurrence of the event. Even if it were assumed that Barr's disclosure of receiving a search query could constitute capturing an event, Barr does not index and store data captured from the search query at a time after receiving the search query, nor would there be any reason to do so. Therefore, the Examiner's assumption that receiving a search query is the same as capturing an event is incompatible with the claim language.

In her Response to the Arguments of the Final Office Action, the Examiner changes her assumption that receiving a search query is the same as "capturing an event" by instead arguing that Barr discloses for example, playing an audio file, editing a video, etc. However, the assumption that any of these events is the same as "capturing an event" is also in error. Rather, there is no disclosure in Barr of "capturing an event" because no data is captured, indexed, or stored from the events.

Barr furthermore does not disclose indexing and storing event data associated with captured events. Although the Examiner points to a document index database 117 in Barr, the document index database 117 does not index and store event data, and instead only indexes and stores media file text fields that are not associated with any event. As recited in Barr, "...each multi-media file in database 118 is stored along with a separate portion of text related to the multi-media record...**This associated text field is used as the basis for generating document index information** (for storage on document index database 117) corresponding to each multi-media file stored in database 118." (Barr, col. 13 lines 5-10). Thus, Barr does not disclose indexing and storing event data.

Turning now to claim 35, it recites:

> ...compiling at least some of the event data to capture at least some of the media file events and at least some of the non-media file events upon the occurrence of the events;
>
> responsive to capturing the media file events and the non-media file events, indexing and storing at least some of the events and associated articles...

Claim 35 requires that the step of indexing and storing are responsive to capturing an event. The step of receiving a search query in Barr cannot disclose capturing an event for at least the same reasons as discussed above. Furthermore, Barr does not disclose indexing and storing events for at least the same reasons as above. Therefore, the rejection to claims 35-36 is improper and the Panel is respectfully requested to indicate the claims are allowable.

III. Rejection Under 35 USC 103(a) in View of Barr and Chen

Claims 1-34 were rejected under 35 USC § 103(a) as allegedly being unpatentable over Barr in view of U.S. Patent No. 6,728,763 B1 to Chen ("Chen") Representative claim 1 recites, in part:

capturing one or more events...

and

...responsive to capturing the one or more events, indexing and storing at least some of the event data and articles associated with the events...

Independent claim 18 recites similar language. Barr and Chen do not disclose or suggest these limitations either alone or in combination. For at least the same reasons as discussed above with respect to claim 36, Barr does not disclose *capturing one or more events* and *responsive to capturing the one or more events, indexing and storing at least some of the event data and articles associated with the events.*

Chen also does not disclose or suggest the claimed invention. Chen discloses playing live and streaming media through a web client's browser. Chen shares the deficiency of Barr that it also does not disclose capturing one or more events having associated event data and responsive to capturing the one or more event, indexing and storing at least some of the event data and articles associated with the events. Therefore, the claimed invention would not have been obvious to a person of ordinary skill in the art at the time of the invention. Dependent claims 2-17 and 19-34 incorporate all the limitations of their respective base claims and are patentable over the cited references for at least the same reasons as above. Therefore, the Panel is requested to remove the rejections to the claims.

IV. Rejection under USC § 101

Claims 1-36 have been rejected under USC § 101 as allegedly being directed to non-statutory subject matter because, according to the Examiner, the language does not include a useful, concrete, and tangible result. Specifically, the Examiner asserts that the claims omit steps for actually "executing a search query." This rejection is improper.

In contrast to the Examiner's remarks, USC § 101 in no way requires the alleged omitted step. Furthermore, the claims do provide a concrete tangible result and are in compliance with USC § 101. For example, claims 1 and 18 each recite "...determining the at least one media file as relevant to the search query..." and "...outputting a result set referencing the at least one media file..." The result set is an example of a useful, concrete, and tangible result. Therefore, the basis for the rejection to the claims under USC § 101 is improper and the Panel is respectfully requested to withdraw the rejection.

V. Summary

Based on the foregoing, Applicants respectfully submit that each of the pending rejections suffers from a clear deficiency in the prima facie case asserted in support of the rejection. Accordingly, Applicants request that the rejections of claims 1-36 be withdrawn.

Respectfully submitted,
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